

### REMARKS

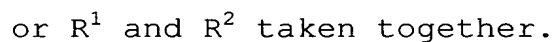
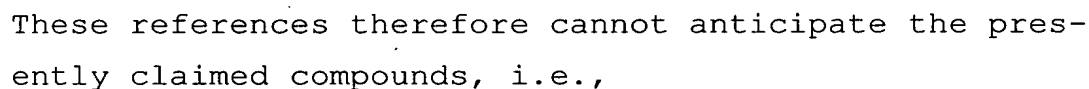
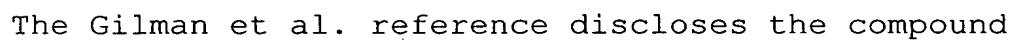
Claims 38-41 are pending in the application. Claim 41 has been allowed. Claim 40 has been cancelled by this amendment. Therefore, claims 38 and 39 are at issue in the application.

Claims 39 and 40 have been withdrawn from further consideration. Applicants traverse the withdrawal of claim 39. The M.P.E.P. cite relied upon by the examiner states that "[I]f on examination the *elected species* is found to be anticipated or render obvious by prior art, the Markush-type claims and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration." (Emphasis added).

In this case, the elected species was found to be *patentable* as opposed to being anticipated or obvious over a cited reference. Accordingly, the withdrawal of claim 39 is improper and should be withdrawn. The withdrawal of claim 40 is moot in view of the amendment to claim 38 and cancellation of claim 40.

Claim 38 stands rejected as being anticipated by a Brown et al. publication and a Gilman et al. publication. In view of the amendment to claim 38, it is submitted that claim 38, and claim 39, are in a form for allowance.

Claim 38 has been amended to recite that  $R^2$  is OH, or that  $R^1$  and  $R^2$  can be taken together. The Brown et al. reference discloses the compound



- 7 -

et al. publications and thereby arrive at the presently claimed compound.

Accordingly, it is submitted that the rejection of claims 38 and 39 as being anticipated by Brown et al. and Gilman et al. should be withdrawn. It also is submitted that claims 38 and 39 would not have been obvious over Brown et al. and Gilman et al., each taken alone or in combination.

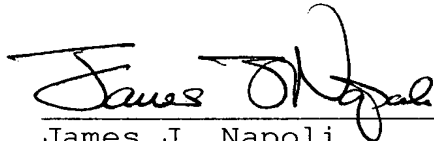
In summary, it is submitted that the claims 38 and 39 are in proper form and scope for allowance. Early and favorable action on the merits is respectfully requested. Claim 41 has been allowed.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

**MARSHALL, GERSTEIN & BORUN LLP**

By



James J. Napoli  
(Registration No. 32,361)  
Attorneys for Applicants  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606  
(312) 474-6300

Chicago, Illinois  
March 2, 2004